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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,697	11/14/2003	Kenneth R. Thurm	THURM-006A	2718

7590 11/29/2004

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EXAMINER

KLEBE, GERALD B

ART UNIT PAPER NUMBER

3618

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,697

Applicant(s)

THURM, KENNETH R.

Examiner

Gerald B. Klebe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

G.B. Klebe
18 November 2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/26/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election / Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Figures 1-5, for an embodiment of a vertically stowable modular multi-purpose trailer having first and second planar decks that fold vertically and capable of transport of a single tandem-wheeled vehicle, such as a motorcycle loaded on the trailer deck

II. Figures 6-11, for an embodiment of a vertically stowable modular multi-purpose trailer having first and second planar decks that fold vertically and having grating panels laterally positioned on the outboard sides of the first and second planar decks and the trailer capable of transporting two such tandem-wheeled vehicles loaded on the deck side-by-side, or a single vehicle having multiple wheels that are arranged in tandem on each side of the vehicle.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Attorney of Record Mr. Kit Stetina, Reg. No. 29,445 on 17 November 2004 a provisional election was made without traverse to prosecute the invention of Species Group I., Figures 1-5. Affirmation of this election must be made by applicant in replying to this Office action.

Upon further consideration, the examiner finds that claims 6 and 17 both read on the non-elected species II, Figures 6-11, and therefore, claims 6 and 17 are hereby withdrawn by the examiner from further consideration in accordance with 37 CFR 1.142(b), as being drawn to a non-elected species.

An examination on the merits of the claims of the elected species follows.

Claims Objections

3. The claims are objected-to for the following:

a. Claim 2 in lines 2-3 recites the limitation "a ground surface"; claim 3 in line 2 and claim 9 in line 3 each recite "the ground". These recitations are awkward since it is not permitted to claim part of the earth. A preferable wording would be --a supporting surface of the trailer--, or a similar recitation.

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- b. Claim 15 in line 2: the word "removable" should be --removably--.

Appropriate correction is required.

Claims Rejections - 35 U.S.C. § 112, 2nd Paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3, in line 2 and claim 9, in line 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 in line 2 and claim 9 in line 3 each recite the limitation "the ground". There is insufficient antecedent basis for this limitation in each of these claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Leib et al. (US 5340145), cited by Applicant.

Leib et al. (-145) discloses a vertically stowable modular multi-purpose trailer comprising:

(re: claim 1) a forward support section (Figs 1 and 2, item 22) comprising,

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a first tubular frame (Fig 1, item 50; refer col 2, lines 3-5 and col 3, lines 41ff) having a main body portion with a first upper platform and rear interface side (taken as the interface where it hingedly connects with the forward interface of the rear support section, 24), and forward trailer neck (taken as combination of items 78, 80 and the connected portion of the trailer hitch 76);

a pair of caster wheels (118; seen in Fig 1 and also shown in Fig 8) attached proximate the rear interface; and

a first planar deck (62) substantially covering the first upper platform;
a rear support section (24) comprising,

a second tubular frame (Fig 3, item 30; taken as the combination of items 32, 34, 36 and as connected with item 38; refer col 2, lines 3-5 and col 3, lines 16ff) having a second upper platform and a forward interface;

a third caster wheel (Fig 2, item 122; seen also in Fig 8) attached proximate the forward interface; and

a second planar deck (46) substantially covering the second upper platform;
a pair of hinge assemblies (88) interconnecting the rear interface and the forward interface;

the trailer adapted to be configured in a deployed configuration (Figs 1-6), wherein the forward support section and rear support section are longitudinally positioned next to each other forming a generally horizontally oriented common planar platform for supporting a payload; and

the trailer adapted to be configured in a vertically stowed configuration (Fig 11), wherein the forward support section and rear support section are adapted to be folded about the

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pair of hinge assemblies (88) such that the forward support section and the rear support section are latitudinally positioned next to each other in a generally vertical orientation; and,

(re: claim 2) wherein, when the trailer is vertically stowed, the pair of caster wheels (118) and the third caster wheel (122) are in contact with a trailer supporting surface (as seen in Fig 11); and,

(re: claim 3) wherein, when the trailer is deployed, the pair of caster wheels and the third caster wheel are elevated from the trailer supporting surface (as seen in fig 1 (items 118) and Fig 2 (item 122)); and,

(re: claim 4) the main body having a recess underneath the first upper platform (not separately numbered; taken as the recessed region between the triangularly configured frame members 52, 54, and 56); and,

(re: claim 5) the trailer being configured to transport a single motorcycle (refer col 1, lines 7-8, and col 6, lines 46-47); and,

(re: claim 11) further comprising an axle (93) attached to the main body portion, an independent torsion suspension system attached to the axle (refer col 4, lines 15-34; and especially refer to lines 20-21), and a pair of wheels and tires (96) rotatably attached to the suspension system; and,

(re: claim 13) further comprising a trailer hitch (76) attached to the forward trailer neck.

EXAMINER'S NOTE: Regarding the recitation of claim 4: "adapted to store a spare wheel and tire"; it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leib et al. (US 5340145) cited by Applicant.

a. Regarding claim 7, as discussed above relative to claim 1 from which claim 7 depends, Leib et al. discloses all of the features of the claim except that the motorcycle rail and wheel chock assembly (Fig 1, item 62) of Leib et al. is fixedly rather than removably attached to the first upper platform.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the trailer disclosure of Leib et al. to have the motorcycle guide rail and wheel chock assembly removably attached to the first upper platform, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art, (*Nerwin v. Erlichman*, 168 USPQ 177, 179.) and it would have been obvious to make this assembly selectively removable and separable from the trailer first upper platform as an engineering design choice in order to provide easy conversion to one or the other of the trailer multi-configurations contemplated by the reference at column 6, lines 45-51.

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b. Regarding claim 10, as discussed above relative to claim 1 from which claim 10 depends, Leib et al. discloses all of the features of the claim except that Leib et al. uses rectangular section steel tube members to construct the first and second tubular frames.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of Leib et al. to instead form the first and second tubular frames of steel having a round section since it has been generally held to be within the skill of a worker in the art to make an element any shape as a matter of obvious engineering choice when the shape is not for any stated reason or any particular purpose. In re Dailey, 357 F.2d 699, 149 USPQ 47 (CCPA 1966).

Therefore, it would have been obvious to one of ordinary skill to make the frame elements of the trailer of Leib et al. in the form of round sectional shaped members in order to eliminate the sharp edges of the rectangular frame elements as a safety measure.

c. Regarding claim 16, as discussed above relative to claim 1 from which claim 16 depends, Leib et al. discloses all of the features of the claim except Leib et al. is silent regarding the size of the trailer flatbed platform.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of Leib et al. regarding the size of the trailer platform, including to size the platform to be approximately 5 feet by 7 feet when the trailer is in its deployed orientation as a simple design choice since it has been held that such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

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9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leib et al. (US 5340145) cited by Applicant, in view of Johnston (US 6102370), cited by Applicant.

As discussed above relative to claim 1 from which claims 8 and 9 depend, Leib et al. discloses all of the features of the claim except Leib et al. is silent regarding provision (re: claim 8) of a loading ramp that may have one end of the ramp (re: claim 9) be attached to a rear end of the rear support section of the trailer and the other end of the ramp positioned to engage the trailer's supporting surface ("ground").

However, Johnston teaches a trailer (Fig 1, item 10) having loading ramps (110) that may be attached to a rear end of the rear support section of the trailer and the other end of the ramp positioned to engage the trailer's ground supporting surface (refer col 5, lines 46-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the trailer of Leib et al. in accordance with the teachings of Johnston to include removable loading ramps each having one end that may be attached to a rear end of the trailer's rear support section and the other end of the ramp positioned to engage the ground, the ramps being adapted to be stored within the rear support section of the trailer as an obvious means to facilitate loading and unloading of a motorcycle or other object being transported on the trailer.

EXAMINER'S NOTE: Regarding the recitation of claim 8 that the at least one loading ramp is "adapted to be stored within the rear support section"; it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leib et al. (US 5340145) cited by Applicant, in view of Harrington (US 6557882).

As discussed above relative to claim 1 from which claim 14 depends, Leib et al. discloses all of the features of the claim except Leib et al. is silent regarding provision of a removable stone guard positioned in a forward region of the forward support section of the trailer.

However, Harrington teaches a trailer having removable stone guards positioned in a forward region of the forward support section of the trailer (Fig 12, combination of items 84 and 86).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosed trailer of Leib et al. to include a removable stone guard removably positioned in a forward region of the forward support section of the trailer as taught by Harrington in order to protect the motorcycle or other objects being transported on the trailer from debris during motion of the trailer behind the towing vehicle.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leib et al. (US 5340145) cited by Applicant, in view of Hiss (GB 2044193).

As discussed above relative to claim 1 from which claim 12 depends, Leib et al. discloses all of the features of the claim except Leib et al. is silent regarding provision of a spare tire and wheel stored within the recess underneath the first upper platform.

However, Hiss discloses a multi-purpose trailer having a spare tire and wheel stored within a recess underneath a platform of the trailer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of Leib et al. in accordance with the

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teachings of Hiss to include a spare tire and wheel stored within the recess underneath the first upper platform of the trailer as disclosed in Leib et al. in order to provide with the trailer itself a readily accessible spare tire and wheel.

Although Hiss teaches the spare tire and wheel stored beneath the rearmost platform of the trailer it would have been obvious to relocate the spare to a position underneath the first upper platform of the trailer since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leib et al. (US 5340145) cited by Applicant, in view of Zenna (US 4752177), cited by Applicant.

As discussed above relative to claim 1 from which claim 15 depends, Leib et al. discloses all of the features of the claim except Leib et al. is silent regarding provision of a utility box.

Zenna teaches a motorcycle transport trailer that includes a utility box removably fastened to the first upper platform of the forward support section.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the trailer of Leib et al. to have a utility box removably fastened to the upper platform of the forward support section in accordance with the teachings of Zenna in order to include on the trailer in proximity to the motorcycle a battery source to charge the motorcycle battery in case of failure and a source of pressurized air to inflate the motorcycle tires.

Prior Art made of Record

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Browning, of Crawford, of Cromley, Jr., of Albert, and of Bell each

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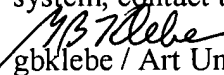
show features in common with some of the other structures of the inventive concept disclosed in the instant application.

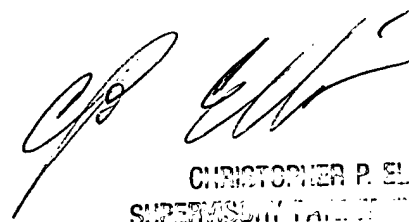
Conclusion

14. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 703-308-2560.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 18-Nov-04


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